

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. MORELAND
and
KURT M. TAUSCHER

Appeal No. 2003-0229
Application 09/768,885

ORDER REMANDING TO EXAMINER

An examination of the file reveals that an Information Disclosure Statement (IDS) was filed April 15, 2002 (Paper No. 13). It is not apparent from the record whether the examiner considered the statement submitted or notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. While a handwritten note appeared on the IDS which stated "See Paper No. 3," it should be noted that it appears that Document No. 1205666A dated 9/16/70 belonging to

Appeal No. 2003-0229
Application 09/768,885

Great Britain and the International Search Report (PCT/ISA/210) were not included as part of Paper No. 3. A communication notifying appellants of the Primary Examiner's decision is required.

In addition, several papers were filed on March 4, 2002 --- Extension of Time (Paper No. 10), Appeal Brief (Paper No. 11) and Amendment Filed With Appeal Brief (no paper number given). Claim 1 which appears in the Appendix attached to the Amendment Filed With Appeal Brief does not comply with section 1206(9) of the Manual of Patent Examining Procedure (MPEP) (8th Ed., August 2001), which states:

The copy of the claims required in the brief Appendix by 37 CFR 1.192(c)(9) should be a clean copy and should not include any markings such as brackets or underlining.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. for consideration of the IDS filed April 15, 2002 (Paper No. 13) and appropriate written notification to appellants regarding the Examiner's decision;

Appeal No. 2003-0229
Application 09/768,885

2. for notification to appellants to submit a new Appendix to the Appeal Brief filed March 4, 2002 (Paper No. 11) which contains a correct copy of claim 1, or for the examiner to issue a supplemental Examiner's Answer to officially correct the Appendix; and

3. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: _____
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DS:psb

Appeal No. 2003-0229
Application 09/768,885

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